

REMARKS

Claims 1-65 are pending. Claims 1-65 have been rejected under 35 U.S.C. 251 for allegedly failing to establish an error within the meaning of the statute. Additionally, the specification amendment submitted on May 11, 2006 contains certain errors.

CHAIN OF TITLE

The application stands objected to under 37 C.F.R. 1.172(a) as the assignee has allegedly not established its ownership interest in the patent for which reissue is being requested. Applicants are submitting herewith USPTO Form SB/96 which details the chain of title for the present application. Therefore, this objection should be withdrawn.

35 U.S.C. 251

Claims 1-65 stand rejected under 35 U.S.C. 251 for allegedly failing to establish an error within the meaning of the statute. The Office Action alleges that the Applicants have neither alleged that the patent is wholly or partly inoperative or invalid because the patentee is claiming "more than" the patentee had a right to claim, nor narrowed or cancelled any patented claim. Additionally, the Office Action states that the existing claims already "cover" the invention defined by the newly added claims. Therefore, the Office Action concludes that the patent is not regarded as being wholly or partly invalid due to one or more patent claims being invalid.

Applicants respectfully submit that the claims do comply with the statute, especially in view of present case law. The Board of Patent Appeals and Interferences has held that "the

practice of submitting claims as a hedge against the possibility of invalidity of original claims has been judicially sanctioned.” *Ex parte Parks*, 30 U.S.P.Q. 2d. 1234, 1237 (1993). In *Parks*, the Board cited Federal Circuit and Court of Customs and Patent Appeals cases in support of its holding that “hedge claims” are acceptable to qualify as requisite error under 35 U.S.C. 251. (citing *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 882 F.2d 1556 (Fed. Cir. 1989); *In re Altenpohl*, 500 F.2d 1151 (C.C.P.A. 1974); *In re Handel*, 312 F.2d 943 (C.C.P.A. 1963)). Regarding “hedge claims,” the Federal Circuit in *Hewlett-Packard* emphasized that “[a]lthough neither ‘more’ nor ‘less’ in the sense of scope of the claims, the practice of allowing reissue for the purpose of including narrower claims as a hedge against the possibility of invalidation of a broad claim has been tacitly approved …” 882 F.2d at 1565.

In *Parks*, all of the claims were rejected by the Patent Office under 35 U.S.C. 251 for lack of the requisite “error.” The Board determined that submitting “hedge claims”, which are narrower in scope than broader claims or are intermediate in scope, is acceptable practice in a reissue application which satisfies the intent of 35 U.S.C. 251.

Similarly to *Parks*, Applicants have submitted “hedge claims” which satisfy the requisite error in 35 U.S.C. 251. As discussed above, this practice has been approved by the Board of Patent Appeals and Interferences as well as the Federal Circuit. Applicants do not believe that the original patent claims are invalid, but are presenting narrower claims against a “hedge” against the possibility of the invalidity of any of these claims. Therefore, the rejection of claims 1-65 should be withdrawn.

SPECIFICATION AMENDMENTS

The Office Action indicated formatting errors found in the amended specification submitted on May 11, 2006. Applicants are submitting herewith specification amendments following the correct format by utilizing bracketing instead of strikethrough for deletions. Favorable consideration of this amendment is requested.

CONCLUSION

Therefore, in view of the above amendments and the enclosed Statement Under 37 C.F.R. 3.73(b), Applicants respectfully request that the rejections and objections be withdrawn and that claims 1-65 be allowed. Should it be necessary, Applicants' undersigned attorney requests that the Primary Examiner contact him by telephone to deal with any other matters that may arise in connection with the completion of the prosecution of the application.

Respectfully submitted,

By _____

Joel E. Siegel, Reg. No. 25,440

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Attorneys for Applicant
Wood, Phillips, Katz, Clark & Mortimer
Citicorp Center, Suite 3800
500 West Madison Street
Chicago, Illinois 60661-2562
(312) 876-1800



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STATEMENT UNDER 37 CFR 3.73(b)

Applicant/Patent Owner: Cordis Corporation

Application No./Patent No.: 5,102,417 Filed/Issue Date: April 7, 1992

Entitled:

Cordis Corporation a corporation
(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

- the assignee of the entire right, title, and interest; or
- an assignee of less than the entire right, title and interest
(The extent (by percentage) of its ownership interest is _____ %)

in the patent application/patent identified above by virtue of either:

A An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

OR

B A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as follows:

1. From: Julio C. Palma To: Expandable Grafts Partnership
The document was recorded in the United States Patent and Trademark Office at
Reel 005169, Frame 0816 or for which a copy thereof is attached.
2. From: Richard A. Schatz To: Expandable Grafts Partnership
The document was recorded in the United States Patent and Trademark Office at
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3. From: Expandable Grafts Partnership To: Cordis Corporation
The document was recorded in the United States Patent and Trademark Office at
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- Additional documents in the chain of title are listed on a supplemental sheet.
- As required by 37 CFR 3.73(b)(1)(i), the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11.

[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, to record the assignment in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

Signature

Paul A. Coletti

Printed or Typed Name

6/7/07

Date

732-524-2815

Telephone Number

Assistant Secretary

Title

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.